

REMARKS

Claims 6-8 are pending in this application and claims 6-8 are rejected.

At page 2 of the Office Action, claims 6 and 8 are rejected under 35 USC § 112, first paragraph, as not complying with the written description requirement.

Applicants asserted in the Response filed April 6, 2004 that the present claims are fully in compliance with the written description requirement because the present specification discloses numerous mGluR1 antagonists, and because the term “mGluR1 antagonist” is a term of art that embraces particular known compounds.

In the present Office Action, the Examiner states that these arguments are not persuasive because the structure of compounds “having mGluR1 antagonism” and the potential of these compounds for treating acute stage ischemic stroke must be determined on a case-to-case basis by “painstaking” experimental study. The Examiner concludes that the present claims do not comply with the written description requirement because one of ordinary skill in the art would be burdened with undue experimentation to determine all compounds that are mGluR1 antagonists and that would be capable of treating acute stage ischemic stroke.

This rejection is improper. The present Office Action, although made final by the Examiner, sets forth a new ground of rejection as described below.

The Examiner has conflated the written description requirement and the enablement requirement, in spite of the fact that, under U.S. patent law, written description and enablement are separate and distinct requirements. See MPEP 2164. The relevant inquiry to determine

compliance with the written description requirement is: Does the specification allow persons of ordinary skill in the art to understand that the inventors had possession of the claimed invention as of the effective filing date? See MPEP 2163. The relevant inquiry to determine compliance with the enablement requirement is: Is undue experimentation required for one of ordinary skill in the art to practice the invention commensurate with the scope of the claims? See MPEP 2164.

Thus, the Examiner's assertion that claims 6 and 8 do not comply with the written description requirement because undue experimentation is necessary to practice the invention is clearly improper for combining patentability requirements that are separate and distinct.

In a telephone call with the Examiner on August 30, 2004, requesting withdrawal of the finality of the action on the basis that it sets forth a new ground of rejection, the Examiner stated that if Applicants reply to this Office Action by describing that the Examiner's comments are not properly directed to the written description requirement, she will issue a new Office Action and more appropriately address Applicants' previous remarks according to the written description requirement.

Accordingly, Applicants request that the Examiner withdraw the outstanding rejection and allow the present application to issue in view of Applicants' remarks filed April 6, 2004, which Applicants believe sufficiently address the issue of written description.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

U.S. Appln. No. 09/601,505
Response Under 37 CFR 1.116

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

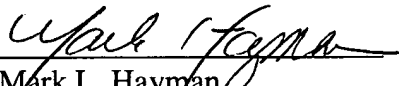
Respectfully submitted,

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